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Malcolm R. Fowler

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SPECKMAN LAW GROUP
1501 Western Avenue, Suite 100
Seattle, WA 98101

EXAMINER

DURAN, ARTHUR D

ART UNIT

PAPER NUMBER

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/935,884

Applicant(s)

FOWLER ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15, 17-25, 27-30, 32-34, 36-58 and 68-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15, 17-25, 27-30, 32-34, 36-58 and 68-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-13, 15, 17-25, 27-30, 32-34, 36-58, and 68-85 have been examined.

Response to Amendment

2. The Amendment filed on 2/5/07 is insufficient to overcome the prior rejection.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/5/07 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-12, 17-25, 27-32, 39-53, 55-62, 68, 69, 71-73, 75-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (20040098317).

Claim 1, 42, 59, 62, 68, 69, 71-73, 75-77, 79: Postrel discloses an automated marketing system implemented using a host controller system, comprising:

acquiring a user identifier, a merchant identifier, and a user behavior identifier at a point of transaction and communicating each of the identifiers to a host controller system over a communications network (Fig. 2; Fig. 4; Fig. 5);

validating eligibility of at least one of the user identifier, the merchant identifier and the user behavior identifier to determine eligibility for participation in at least one marketing program (Fig. 2; Fig. 4; Fig. 5; Fig. 6);

performing a rate calculation processing step to determine eligibility of the user, the merchant and the user behavior for an award based on a preselected set of criteria (Fig. 5; Fig. 6; Fig. 4); and

communicating information relating to delivery of an award or an updated award status condition to the point of transaction over a communications network (Fig. 6; Fig. 4; Fig. 5).

Also, in regards to claim 42, Postrel further discloses accessing a user database from a host controller system, the user database associating a user identifier with additional user demographic information (Fig. 5); associating the user identifier with the additional user demographic information and validating the eligibility of the user to participate in at least one marketing program based on the user identifier and/or the additional user demographic information (Fig. 4; Fig. 5; Fig. 6).

Also, in regards to claim 59, Postrel further discloses validating eligibility of the merchant identifier for redemption of the award; performing a rate calculation processing step to determine whether the award balance satisfies the redemption inquiry and determining a redemption status; communicating the redemption status to the point of

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transaction (Fig. 4; Fig. 5; Fig. 6).

Also, in regards to claim 62, Postrel further discloses implementing an award program in which successive qualifying behaviors of specified qualifying users at one or more qualifying merchant(s) produces successively different awards (Fig. 4; Fig. 5; Fig. 6; Paragraph [53]; Paragraph [54], 'Access to video games may be afforded to the traveler where the availability of different games depends on the number of reward points traded in by the traveler.'; Paragraph [13, 32, 33]). Notice in these citations from Postrel that the user(s) performs successive qualifying behaviors, acquires more and more points in the system as more behaviors are performed, and that the different amounts of user points allows the user access to different awards as the amount of points increases.

Additionally, Postrel discloses implementing award redemption at the point of transaction (Fig. 4; Fig. 5; Fig. 6; ([42])).

Postrel does not explicitly disclose utilizing user demographic information. However, Postrel disclose utilizing user account information, user credit card information, user smart card information (as disclosed above), user registration/name/login information, and user profile and preference and account information (Fig. 5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Postrel can utilize user demographic information. One would have been motivated to do this in order to better present the user content of interest ([8, 27]).

Also, in further regards to claim 42, Postrel discloses utilizing user preference, hobby, interest, demographic information (Fig. 5, Fig. 8). And, Postrel discloses utilizing demographic/preference information to determine the user's eligibility to participate in

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marketing programs ([15, 34]). Note that the servers can utilize the information to determine which programs to notify the user concerning participation in or when or whether to advertise/market to a user.

Additionally, Postrel makes awards or determine eligibility for awards ([4, 5, 10, 11, 15, 29, 42]; Fig. 3). Note that the awards are made at time of purchase based on the agreement for, for example, dollars utilized in purchase to points awarded ratio. Also, notice the preselected award criterion can be that the user is making a purchase or making a purchase utilizing dollars where the dollar amount is rewarded. Also, notice that Postrel states that these rewards at time of purchase are old, well known, and obvious. Also, Postrel discloses a rate calculation for rewards at time of purchase (Fig. 3, citations preceding). Also, note that Postrel gives a certain amount of points for certain dollars spent and that this qualifies as a rate calculation where the rate is the amount of points per dollar spent.

Also, Postrel discloses points/awards provided at time of transaction ([4, 5, 10, 11, 15, 29, 42]; Fig. 3).

Also, Postrel discloses point of transaction, identifiers, swiping, and the use of financial instruments at the point of transaction, please see these citations concerning the point of transaction, the use of cards, the use of credit cards, the use of smart cards ([4, 5, 10, 11, 15, 29, 42]; Fig. 3). Also, see the reference to cards or credit cards in Figures 1, 2, 4 (Figures 1, 2, 4).

Also, Postrel discloses marketing methods, please see these citations concerning promotions and targeted promotions and user targeting ([15, 34]).

Additionally, Postrel does not explicitly disclose that the reward program identifier and credit card identifier can be sent to different parties at time of transaction. However, Postrel

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discloses both a reward program identifier and host and also a credit card identifier and credit card company (Fig. 2; Fig. 4; Fig. 5; [3, 15, 29]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that the separate information concerning the user can be reported to separate companies/hosts. One would have been motivated to do this in order to allow the user to utilize different credit cards with the same reward system (Fig. 2; Fig. 4; Fig. 5).

Additionally, Postrel discloses an automated marketing/advertising method ([8, 12, 17, 27, 29, 47]). Postrel further discloses promotions and targeted promotions and user targeting (15, 34). Postrel further discloses that there are a plurality of marketing methods that are administered by a central host controller (Figure 4 and Figure 5; [15]). Note in Figure 5 that there are numerous 'Merchant Offers' and numerous 'Merchant Connection Profiles'. Also, note in Figure 5 that the Trade Server (item 54) acts as a central host controller and that the Merchant (30) is remote from the Trade Server. Figure 5 also discloses individual user accounts and also individual merchant accounts ('User Accounts', 'Merchant Connection Profiles'). Hence, Figure 5 discloses an automated marketing method implemented using a host controller system administering a plurality of marketing programs and involves acquiring a unique user identifier, a unique merchant identifier, and that the merchant and/or user can be remote from the host controller system.

Postrel further describes how the trading server functions as a central host controller ([36, 37]). Also, notice that in Fig. 5 all the functions of database 54 are part of the trade server 20 (Figure 5; [31], 'as defined in a database 54 on the trading server as shown in FIG. 5.)

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Postrel further discloses a matrix/table rules database that can be referenced to determine the value of particular user actions/behaviors (Figures 3, 5, 9; [36, 3, 15, 29, 33]). Note in Figure 3 that different behaviors receive different amounts of rewards. Also, note in Figure 5 that the 'Merchant Offers' discloses the different offers for different behaviors by users. And, in Figure 9, item 902, Merchant Offers are communicated to the user.

Also, in regards to demographic information, Postrel discloses utilizing user preference, hobbie, interest, demographic information (Fig. 5, Fig. 8). Postrel discloses utilizing demographic information to determine the user's eligibility to participate in marketing programs ([15, 34]). Note that the servers can utilize the information to determine which programs to notify the user concerning participation in.

Also, Postrel Figure 7 further discloses the user utilizing the system at a point of transaction remote from the host controller system (Figure 7). And, Examiner further notes that Postrel discloses points/awards provided at time of transaction at the merchant/POS/remote location ([4,5, 10, 11, 15, 29, 42]; Fig. 3, 4, 5). In further regards to transactions at the merchant/POS/remote location, Postrel discloses concerning point of transaction, identifiers, swiping, and the use of financial instruments at the point of transaction, please see these citations concerning the point of transaction, the use of cards, the use of credit cards, the use of smart cards ([4, 5, 10, 11, 15, 29, 42]; Fig. 3). Also, see the reference to cards or credit cards in Figures 1, 2, 4 (Figures 1, 2, 4).

Claim 2: Postrel discloses an automated marketing system according to claim 1, additionally comprising updating at least one of a user, merchant and user behavior file and storing the user, merchant and user behavior identifier (Fig. 4; Fig. 5).

Claim 3: Postrel discloses an automated marketing system according to claim 1, additionally comprising communicating information relating to delivery of an award or an updated award status condition to the user at the point of transaction (Fig. 2; Fig. 4; Fig. 5; Fig. 6).

Claim 4, 60, 61: Postrel discloses an automated marketing system according to claim 1, additionally comprising communicating information relating to identification of the user, user behavior, the delivery of an award, or an updated award status condition to the merchant at the point of transaction (Fig. 4; Fig. 5; Fig. 6; Fig. 7).

Claim 6: Postrel discloses an automated marketing system according to claim 1, additionally comprising displaying information relating to delivery of an award or an updated award status condition at the point of transaction (Fig. 2; Fig. 4; Fig. 5; Fig. 6; Fig. 7).

Claim 7: Postrel discloses an automated marketing system according to claim 1, additionally comprising performing an award prioritization processing step after the rate calculating processing step when a transaction is eligible for multiple awards ([33, 46]).

Claim 8: Postrel discloses an automated marketing system according to claim 1, wherein user eligibility for participation in at least one marketing program is based on at least one of the qualifiers selected from the group consisting of membership in a participating organization; participation in a loyalty program; participation in a gift card program; holding of a credit instrument; holding of a debit instrument; holding of an account; membership in a subscriber base; participation in a service; and simultaneous or prior purchase of qualifying good(s) or service(s) (Fig. 2; Fig. 4; Fig. 5; Fig. 6; Fig. 7).

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Claim 9: Postrel discloses an automated marketing system according to claim 1, wherein the award is expressed in an award currency selected from the group consisting of points, gift cards, gift certificates, instant prizes, custom coupons, merchandise, credit; services; benefits; and cash (Fig. 4; Fig. 5).

Claim 10: Postrel discloses an automated marketing system according to claim 1, wherein the user behavior identifier is selected from the group consisting of: identification of predetermined item(s) purchased; identification of predetermined service(s) purchased; identification of item type purchased; identification of service type purchased; purchase price of individual item(s); purchase price of individual service(s); presence of user in a location; purchase in a location; purchase value total; purchase date; purchase time; purchase location; award delivered; and award accumulated (Fig. 4; Fig. 5).

Claim 11: Postrel discloses an automated marketing system according to claim 1, additionally comprising means for modifying the eligibility of at least one of the user identifier, the merchant identifier and the user behavior identifier to determine eligibility for participation in at least one marketing program (Fig. 6; Fig. 8).

Claim 12: Postrel discloses an automated marketing system according to claim 1, additionally comprising means for modifying the rate calculation processing step for determining eligibility of the user, the merchant and the user behavior for an award based on a modified set of criteria different from the preselected set of criteria (Fig. 4; Fig. 5; Fig. 9).

Claim 17: Postrel discloses an automated marketing system according to claim 1, wherein qualifying customer behaviors are accumulated over a time period to calculate awards ([12], 'period').

Claim 18: Postrel discloses a automated marketing system according to claim 1, wherein the host controller system additionally accesses user behavior historical information based on the user identifier, and the rate calculation processing step determines the eligibility of the user, merchant and user behavior for an award based, at least in part, on the user behavior historical information (Fig. 4; Fig. 5).

Claim 19: Postrel discloses the above. Postrel does not explicitly disclose utilizing user demographic information. However, Postrel disclose utilizing user account information, user credit card information, user smart card information (as disclosed above), user registration/name/login information, and user profile and preference and account information (Fig. 5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Postrel can utilize user demographic information. One would have been motivated to do this in order to better present the user content of interest ([8, 27]).

Claim 20: Postrel discloses an automated marketing system according to claim 1, additionally comprising implementing multiple marketing programs, involving multiple merchants and/or merchant groups, upon validation of one or more user identifier(s) (Fig. 4; Fig. 5).

Claim 21: Postrel discloses an automated marketing system according to claim 1, additionally comprising implementing multiple marketing programs, involving multiple user identifiers or user identifier groups, upon validation of one or more merchant

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identifier(s) (Fig. 4; Fig. 5).

Claim 22, 44: Postrel discloses an automated marketing system according to claim 1, additionally comprising acquiring the user identifier and at least one transaction payment identifier in a single step at the point of transaction (Fig. 2; [42]).

Claim 23: Postrel discloses an automated marketing system according to claim 22, wherein the single step at the point of transaction is a single examination of an identifying Object (Fig. 2; [42]).

Claim 24, 43, 45, 46: Postrel discloses an automated marketing system according to claim 22, wherein the single step at the point of transaction is a single card swipe and the card is a financial instrument (Fig. 2; [42, 33]).

Claim 25: Postrel discloses an automated marketing system according to claim 22, wherein the user identifier, the merchant identifier, the user behavior identifier, and at least one transaction payment identifier are acquired in a single step at the point of transaction; the user identifier, the merchant identifier and the user behavior identifier are communicated to the host controller over a communications network; and the at least one transaction payment identifier is additionally communicated to an appropriate financial institution or intermediate for processing (Fig. 2; Fig. 4; Fig. 5; [3, 15, 29, 33]).

Claim 27: Postrel discloses an automated marketing system according to claim 26, wherein the at least one transaction payment identifier is additionally communicated to the host controller over a communications network (Fig. 4; Fig. 5).

Claim 28: Postrel discloses an automated marketing system according to claim 25, wherein user identifier and at least one transaction payment identifier are communicated to the host controller over a communications network, and transaction payment identifier is additionally communicated from the host controller to an appropriate financial institution or intermediate for processing ([42; 43, 33]; Fig. 4; Fig. 5).

Claim 29: Postrel discloses an automated marketing system according to claim 22, wherein a credit or debit account identifier is acquired at the point of transaction and is communicated to an appropriate institution for validation and approval (Fig. 4; Fig. 5; Fig. 6).

Claim 30: Postrel discloses an automated marketing system according to claim 29, additionally comprising transmitting the customer identifier to the marketing program host controller following validation and approval of the transaction (Fig. 5).

Claim 32, 51: Postrel discloses an automated marketing system according to claim 31, additionally comprising validating eligibility of at least one of the user identifier, the merchant identifier and user behavior identifier to determine eligibility for award redemption, updating the award status condition based on the award redemption, and communicating information relating to redemption of an award to the point of transaction over a communications network (Fig. 4; Fig. 5; Fig. 6).

Claim 39: Postrel discloses an automated marketing system according to claim 1, additionally comprising analyzing data collected relative to user identifications and/or merchant identifications and/or user behaviors and providing data relating to the analysis to qualifying merchants/merchant groups through an Internet Website portal ([5, 9, 32]; Fig. 4; Fig. 5).

Claim 40: Postrel discloses an automated marketing system according to claim 1, wherein a data collection device at the point of transaction acquires the user identifier, the merchant identifier and the user behavior identifier, and the data collection device is selected from the group consisting of electronic registers, optical and magnetic scanners and readers, barcode scanners, magnetic strip scanners, radio frequency receivers, transaction card readers, communications devices, computers, personal digital assistants, telephones and pagers (Fig. 2; [42]).

Claim 41: Postrel discloses an automated marketing system according to claim 1, wherein a personal communications device acquires data relating to at least one of a user identifier, a merchant identifier and a user behavior and communicates the data to the host controller system over a communications network ([14, 28]).

Claim 47: Postrel discloses an automated marketing system of claim 1 or claim 42, in which the user identifier information is detected by recognition of a number, a barcode, a fingerprint, a retinal pattern, or a radio frequency signal (Fig. 2; [42]).

Claim 48: Postrel discloses an automated marketing system of claim 1 or 42, in which data is transmitted to the host controller system via local or regional phone lines, dedicated data transmission lines, cable, cellular, personal communication systems, microwave, radio frequency, fiberoptic, global communications networks or satellite networks ([14, 28, 54]).

Claim 49: Postrel discloses an automated marketing system of claim 1 or 42, in which information relating to delivery of an award or an updated award status condition is transmitted to the point of transaction via local or regional phone lines,

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dedicated data transmission lines, cable, cellular, personal communication systems, microwave, radio frequency, fiberoptic, global communications networks or satellite networks ([14, 28, 54]).

Claim 50: Postrel discloses an automated marketing system of claim 1 or 42, additionally comprising converting awards from different marketing programs into a common award currency and calculating and transferring award balances expressed in the common award currency to the host controller system (Fig. 4; Fig. 5).

Claim 52: Postrel discloses an automated marketing system of claim 50, wherein the common award currency is redeemable through any participating merchant or merchant group (Fig. 4; Fig. 5).

Claim 53: Postrel discloses an automated marketing system of claim 1 or 42, additionally comprising validating the eligibility of at least one of the user identifier, the merchant identifier and the user behavior identifier to determine eligibility for participation in multiple marketing programs (Fig. 4; Fig. 5; Fig. 6).

Claim 55: Postrel discloses an automated marketing system of claim 1 or 42, in which the host controller system administers multiple marketing programs associated with multiple merchants and/or merchant groups, and following acquisition and communication of the user identifier, the host controller validates eligibility of the user identifier to determine eligibility for participation in multiple marketing programs (Fig. 4; Fig. 5).

Claim 56: Postrel discloses an automated marketing system of claim 1 or 42, additionally comprising issuing gift certificates in an award currency usable in at least one marketing

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program administered by the host controller system and redeemable by at least one participating merchant and/or merchant group ([42]).

Claim 57: Postrel discloses an automated marketing system of claim 56, in which the gift certificate in the award currency is associated with the user identifier and communicated to the host controller system, and gift certificate redemption is administered by the host controller system through participating merchants and/or merchant groups (Fig. 5; Fig. 5; Fig. 6).

Claim 58: Postrel discloses an automated marketing system of claim 56, in which the gift certificate information is stored in the host controller system in a common award currency, and is convertible and redeemable through participating merchants and/or merchant groups in multiple currencies (Fig. 4; Fig. 5).

Claim 67: Postrel discloses a system for implementing a marketing program comprising a centralized host controller in communication with a plurality of point of transaction devices by means of a communications system, the centralized host controller additionally in communication with a user/customer database, a merchant database, one or more program matrix rules modules, one or more data management storage & retrieval programs, one or more GIS applications, and a dynamic custom messaging system (Fig. 4; Fig. 5).

Claim 78, 83: Postrel discloses updating the award balance (Figure 5, 7, [38]).

Claim 80: Postrel discloses award program tie-ins ([15]).

Claims 81, 82: Postrel discloses validating the ability of the user to participate in multiple or one marketing programs (Figure 6, item 602, item 606; Figure 7, item 706; Figures 4, 5; [15])

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Claim 84: Postrel discloses that the host controller stored data relating to users, merchants, and user behaviors (Figure 5, item 54; Figure 3).

Claim 85: Postrel discloses a redemption inquiry regarding an award balance (Figure 7, item 710).

5. Claims 5, 54, 66, 70, 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (20040098317) in view of Eggleston (6,061,660).

Claim 5, 54, 66, 70, 74: Postrel discloses the above. Postrel does not explicitly disclose printing receipts. However, Postrel discloses printers ([54]).

Eggleston further discloses printing information relating to delivery of an award or an updated award status condition on a transaction receipt generated at the point of transaction (col 45, lines 5-15).

Eggleston further discloses random prizes and a variety of award schemes (Fig. 20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Eggleston's receipt for awards and variety of prizes and awards to Postrel's awarding a user for certain behaviors. One would have been motivated to do this in order to better track what has been provided to the user (Postrel, Fig. 5) and to provide awards/incentives of interest to the user.

Eggleston further discloses instant win promotions (col 30, lines 10-25; col 42, lines 55-67) and personalized point of sale promotions (col 39, lines 50-65).

Also, in regards to claim 5, Examiner notes that Applicant uses the word "or" in this claim.

6. Claims 13-15, 63-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (20040098317) in view of Bednarek (20050251440)

Claim 13, 15, 63-65: Postrel discloses the above. Postrel does not explicitly disclose increasing or decreasing awards based on frequency of utilization during a time period.

However, Bednarek discloses increasing or decreasing awards based on frequency of utilization during a time period (Bednarek, [295, 297, 298]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Bednarek's adaptable rewards to Postrel's variety of awarding structures (Postrel, Fig. 4; Fig. 5). One would have been motivated to do this in order to present awards that better incite certain user behaviors.

7. Claims 33, 34, 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (20040098317) view of Bednarek (20050251440) in view of Fitzpatrick (20020046138).

Postrel discloses the above. Postrel does not explicitly disclose charging a fee to the sponsors/merchants for utilizing the system.

However, Bedarek discloses increasing or decreasing awards based on frequency of utilization during a time period (Bednarek, [295, 297, 298]).

Fitzpatrick discloses variable fees, flat fees, percentage fees, fees tied to the prizes for an award program ([97, 110, 100]; claims 8, 12, 13, 46).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Fitzpatrick's variable fees tied to the awards and Bedarek's

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varying awards Postrel's awards program with multiple sponsors. One would have been motivated to do this in order to provide a better way to compensate for the expenses associated with running an awards program.

Response to Arguments

8. Applicant's arguments with respect to the claims have been considered but are not found persuasive.

On page 17 of the Applicant's Remarks dated 2/5/07, Applicant states that Postrel does not render obvious, "administering a plurality of marketing programs; . . . remote from the host controller system; and. . . identifying a program matrix rules module associated with the at least one marketing program upon validation of eligibility of an identifier for participation in a marketing program; at the host controller system; from the host controller system to the point of transaction."

Beginning on page 22, Applicant states, "Neither Postrel nor the other prior art references of record discloses a host controller system capable of performing these disparate steps and communicating with a remote point of transaction. . . The system of Postrel. . . does not utilize a host controller system or any other system that performs the functions specified in applicants' claims. . . Claim 1 specifies, inter alia, an automated marketing method implemented using a host controller system administering a plurality of marketing programs and involves acquiring a unique user identifier, a unique merchant identifier, and a user behavior identifier at a point of transaction remote from the host controller system."

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being

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referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Also, Examiner notes that it must be presumed that the artisan knows something about the art apart from what the references disclose. *In re Jacobv*, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references disclose. *In re Jacoby*. Also, the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion a particular reference. *In re Bozek*, 416 F.2d 1385, USPQ 545 (CCPA 1969). And, every reference relies to some extent on knowledge or persons skilled in the art to complement that which is disclosed therein. *In re Bode*, 550 F.2d 656, USPQ 12 (CCPA 1977).

Also, Examiner notes that the person of ordinary skill in the art is a hypothetical person who is presumed to know the relevant prior art. *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955,962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986).

In determining this skill level, the court may consider various factors including "type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field." *Id.*, cited in *In re GPAC*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995). In a given case, every factor may not be present, and one or more factors may predominate. *Id.* at 962-63, 1 USPQ2d at 1201.

Also, Examiner notes the requirement of a showing of a "teaching, suggestion, or motivation" to modify or combine the prior art teachings. This requirement was recently described in *In re Kahn*, 441 F.2d 977, 78 USPQ2d 1329 (Fed. Cir. 2006):

[T]he "motivation-suggestion-teaching" test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. From this it may be determined whether the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art- i.e., the understandings and knowledge of persons having ordinary skill in the art at the time of the invention- support the legal conclusion of obviousness. (internal citations omitted). *Id.* at 988, 78 USPQ2d at 1337.

"In considering motivation in the obviousness analysis, the problem examined is not the specific problem solved by the invention but the general problem that confronted the inventor before the invention was made." *Kahn*, 441 F.3d at 988, 78 USPQ2d at 1336 (citations omitted).

To establish a prima facie case of obviousness, the references being combined do not need to explicitly suggest combining their teachings. See e.g., *In re Johnston*, 435 F.3d 1381, 1385, 77 USPQ2d 1788, 1790-91 (Fed. Cir. 2006) (citing *Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1221-22 (Fed. Cir. 2003)) ("[t]he suggestion or motivation to combine references does not have to be stated expressly; rather it may be shown by reference to the prior art itself, to the nature of the problem solved by the claimed invention, or to the knowledge of one of ordinary skill in the art."); and *Kahn*, 441 F.3d at 987-88, 78 USPQ2d at 1337-38 ("the teaching, motivation, or suggestion may be implicit from the prior art

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as a whole, rather than expressly stated in the references").

In fact, an explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art. *Johnston*, 435 F.3d at 1385, 77 USPQ2d at 1790-91. As such, the prior art may explicitly or implicitly suggested the claimed combination. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art."

Kahn, 441 F.3d at 987-88, 78 USPQ2d at 1336 (quoting *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)).

And, Postrel discloses an automated marketing/advertising method ([8, 12, 17, 27, 29, 47]). Postrel further discloses promotions and targeted promotions and user targeting (15, 34). Postrel further discloses that there are a plurality of marketing methods that are administered by a central host controller (Figure 4 and Figure 5; [15]). Note in Figure 5 that there are numerous 'Merchant Offers' and numerous 'Merchant Connection Profiles'. Also, note in Figure 5 that the Trade Server (item 54) acts as a central host controller and that the Merchant (30) is remote from the Trade Server. Figure 5 also discloses individual user accounts and also individual merchant accounts ('User Accounts', 'Merchant Connection Profiles'). Hence, Figure 5 discloses an automated marketing method implemented using a host controller system administering a plurality of marketing programs and involves acquiring a unique user identifier, a unique merchant identifier, and that the merchant and/or user can be remote from the host controller system.

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Postrel further describes how the trading server functions as a central host controller ([36, 37]). Also, notice that in Fig. 5 all the functions of database 54 are part of the trade server 20 (Figure 5; [31], 'as defined in a database 54 on the trading server as shown in FIG. 5.)

Postrel further discloses a matrix/table rules database that can be referenced to determine the value of particular user actions/behaviors (Figures 3, 5, 9; [36, 3, 15, 29, 33]). Note in Figure 3 that different behaviors receive different amounts of rewards. Also, note in Figure 5 that the 'Merchant Offers' discloses the different offers for different behaviors by users. And, in Figure 9, item 902, Merchant Offers are communicated to the user.

Also, in regards to demographic information, Postrel discloses utilizing user preference, hobby, interest, demographic information (Fig. 5, Fig. 8). Postrel discloses utilizing demographic information to determine the user's eligibility to participate in marketing programs ([15, 34]). Note that the servers can utilize the information to determine which programs to notify the user concerning participation in.

Also, Postrel Figure 7 further discloses the user utilizing the system at a point of transaction remote from the host controller system (Figure 7). And, Examiner further notes that Postrel discloses points/awards provided at time of transaction at the merchant/POS/remote location ([4, 5, 10, 11, 15, 29, 42]; Fig. 3, 4, 5). In further regards to transactions at the merchant/POS/remote location, Postrel discloses concerning point of transaction, identifiers, swiping, and the use of financial instruments at the point of transaction, please see these citations concerning the point of transaction, the use of cards, the use of credit cards, the use of smart cards ([4, 5, 10, 11, 15, 29, 42]; Fig. 3). Also, see the reference to cards or credit cards in Figures 1, 2, 4 (Figures 1, 2, 4).

Also, Postrel makes awards or determine eligibility for awards ([4, 5, 10, 11, 15, 29, 42]; Fig. 3). Note that the awards are made at time of purchase based on the agreement for, for example, dollars utilized in purchase to points awarded ratio. Also, notice the preselected award criterion can be that the user is making a purchase or making a purchase utilizing dollars where the dollar amount is rewarded. Also, notice that Postrel states that these rewards at time of purchase are old, well known, and obvious. Also, Postrel discloses a rate calculation for rewards at time of purchase (Fig. 3, citations preceding). Also, note that Postrel gives a certain amount of points for certain dollars spent and that this qualifies as a rate calculation where the rate is the amount of points per dollar spent.

Hence, Postrel renders obvious an automated marketing method implemented using a host controller system administering a plurality of marketing programs and involves acquiring a unique user identifier, a unique merchant identifier, and a user behavior identifier at a point of transaction remote from the host controller system; and also utilizing a program matrix rules module.

Hence, Postrel renders obvious the features of the Applicant's claims.

Also, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

For example, the claims minimally define the matrix of rules. Hence, the matrix of rules can be interpreted broadly.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a) Gardenswartz (2002/0004754) discloses demographic criteria targeted promotins (Figures, 2a, 2b, 4a, 4b);
- b) Deaton (5,687,322) discloses targeting and point of sale promotions.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arthur Duran
Primary Examiner
2/22/2007